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EXAMINER

DINH, DUNG C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/525,926
Filing Date: March 15, 2000
Appellant(s): SMITH ET AL.

William H. Bollman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/17/2005
appealing from the Office action mailed 6/20/2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. The amendment after final (8/17/05) canceled claims 9, 10, 29, 47, 49 and incorporated the canceled matter into the independent claims. As stated in the Advisory Action (8/31/05), the amended claims will be entered

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upon filing of an appeal and the claims will be rejected based upon Borgan, Bunney, WebTV posting and in further combination with Ramasubramani as was used to reject claim 9 in the Final Office action (6/20/05).

Therefore the correct grounds of rejection are:

(A) Claims 1-7, 11, 12, 20-27, 31, 39-45, 49 and 50 are rejected under 35 USC 103(a) as being unpatentable over Borgan et al. US patent 6,459,892 and further in view of Bunney et al. US patent 6,446,112; "WebTV to IRC Proxy debuts on SorceryNet", USENET posting in alt.online-service.webtv 10/18/1999 (WebTV Posting) and Ramasubramani et al US patent 6,314,108.

(B) Claims 8, 46, 51-56 are rejected under 35 USC 103(a) as being unpatentable over Borgan, Bunney, WebTV Posting, Ramasubramani, and further in view of Gudjonsson et al US patent 6,564,261.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6459892	Borgan et al.	10-2002
6,446,112	Bunney et al.	3-17-1999
6314108	Ramasubramani et al.	4-30-1998

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6,564,261

Gudjonsson et al.

5-10-1999

"WebTV to IRC Proxy debuts on SorceryNet," USENET posting in alt.online-service.webtv 10/18/1999. (Retrieved from www.google.com/groups 4/28/04).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, 11, 12, 20-27, 31, 39-45, 49 and 50 are rejected under 35 USC 103(a) as being unpatentable over Burgan et al. US patent 6,459,892 and further in view of Bunney et al. US patent 6,446,112; "WebTV to IRC Proxy debuts on SorceryNet", USENET posting in alt.online-service.webtv 10/18/1999 (WebTV Posting) and Ramasubramani et al US patent 6,314,108.

As per claim 1, Burgan teaches a method for providing chat among wireless mobile device, comprising:

placing a mobile chat proxy server [fig.1 chat server 48] in a direct communication path with a wireless gateway server [fig.1 system controller 22] supporting said mobile device;

a non-Internet Relay Chat program for sending messages [fig.8 #160 - since the wireless chat program 160 is for chatting within Burgan wireless network via mobile chat server

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48 and the mobile chat server 48 is not an IRC server, the program 160 is a "non-Internet Relay Chat program" as claimed].

Burgan provides wireless chat service but does not disclose providing Internet Relay Chat service. Burgan does not teach the chat proxy server 48 connects to a standard Internet Relay Chat (IRC) server.

In similar field of providing network services to subscribers, Bunney teaches a method for permitting a mobile device (fig.5 #3) to originate chat session with a standard IRC server (fig.5 #40) by providing a chat proxy server (fig.5 #20) with direct connection to a standard IRC server. The chat proxy server intercepts chat commands from the mobile device, converts non-standard data in the commands to one that conforms to IRC standard, and forwards the chat commands to the standard IRC server. The chat proxy relays chat data from the IRC server to the device to permit the user to participate in IRC chat channel. (See fig.5, col.1 lines 18-20, col.2 lines 6-17, col.10 line 60 to col.11 line 49).

The WebTV Posting advertised a chat proxy for permitting limited functionality client devices (WebTV) to participate fully (as if they are personal computers) in IRC chat network by intercepting, translating, and forwarding chat commands from a WebTV user to the IRC server.

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Bunney discloses IRC enables a user to chat with other users world-wide (col.1 lines 17-29). The WebTV Posting clearly shows the desire of subscribers to chat not just with members within a service (WebTV) or limited capability chat (limited command set provided by the web-based chat) but to chat with wider bases of users and "to take full advantage of channel and nickname services" of IRC network and "doing everything a computer users can do." Hence, one of ordinary skill in the art would have motivated to combine the teaching of Bunney and the WebTV Posting with Burgan to provide a chat proxy in communication with a standard IRC server that provide translation of the wireless chat commands to IRC chat commands because it would have enabled the wireless mobile users of Burgan to fully participate in IRC network to chat with world-wide users and have full control the chat session as that of computer users.

Burgan does not disclose that his wireless gateway server (22) is a wireless Internet gateway. However, it is well known in the art to provide a wireless Internet gateway for connecting a wireless mobile device to the Internet (see Ramasubramani fig.1 gateway 106, col.1 lines 30-37). IRC chatting requires an access to the Internet; hence, it is obvious that Burgan system as modified would have had a wireless Internet gateway.

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Furthermore, it would have been obvious for one of ordinary skill in the art to provide a wireless Internet gateway with Burgan because it would have enabled the wireless clients to browse the Internet as well as participating in IRC network.

As per claim 2, Bunney discloses the mobile device participated in chat channel [col.11 lines 25-49]. It is apparent the a wireless mobile device in Burgan as modified would be participating in the chat channel by the effect of the proxy forwarding commands from the mobile device and relaying chat data from the IRC server to the mobile device.

As per claim 3, Burgan teaches the mobile device being a wireless mobile phone [fig.1 #38]. Bunney discloses the mobile device being a mobile telephone [col.3 lines 38-20].

As per claim 4, Bunney discloses the mobile device originated the access to the IRC channel [col.12 lines 9-15].

As per claim 5, Bunney and the WebTV posting disclose the IRC proxy server interprets the IRC commands from the mobile device [Bunney col.11 line 41-48, col.12 lines 1-11], [WebTV posting "your 'slash commands' ... are intercepted at the proxy and converted to the appropriate ircd (irc server) commands."]

As per claims 6 and 7, the Burgan does not specifically disclose communication with the mobile device via IWF or SMPP interfaces. These interfaces are well known protocols for

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communicating data and text to mobile devices (see Ramasubramani col.1 lines 20-29). Hence, it would have been obvious for one of ordinary skill in the art to use IWF and SMPP because it would have ensured the system compatibility with existing wireless mobile devices.

As per claim 11, Burgan teaches summoning other mobile device to join a chat channel [col.3 line 65 to col.4 line 9].

As per claims 20-30, and 39-45, 47, 49, they are rejected under the same rationale as for claims 1-11 above.

As per claims 12, 31, and 50, they are rejected under the same rationale as for claim 1 above. The references do not specifically disclose a ghost command. However, ghosting is merely a standard IRC user "mode +i" - invisible mode command [see Applicant' specification page 28]. The usage of user mode +i command is well known in the IRC network to hide a user nickname from appearing in a channel user listing. This permits the user to be in a chat channel without being easily detected by other users in the chat channel. It would have been obvious for one of ordinary skill in the art to provide full-set of IRC commands functionality in the proxy server including the ghosting function (mode +i command) because it would have enabled full IRC commands compatibility and permitted the user

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to monitor a chat channel without publicly revealing his present.

Claims 8, 46, 51-56 are rejected under 35 USC 103(a) as being unpatentable over Burgan, Bunney, WebTV Posting, Ramasubramani, and further in view of Gudjonsson et al. US patent 6,564,261.

As per claims 8, 46, 51-56, Burgan does not specifically disclose using a "short message system" and the chat program on the mobile device being a short message service program. However it is well known in the wireless mobile communication art to have short message service program and system controller for communicating short message among mobile devices. Burgan teaches the wireless devices can send text message to each other (col.3 lines 10-22). This can constitutes a "short message system" as claimed. Hence, it is inherent that the system as modified would have "short message service" capability. Furthermore, in similar field of text communication, Gudjonsson discloses the usage of short message service for mobile users to chat with PC users (see col.3 line 57 "PC to SMS"). Hence, it would have been obvious for one of ordinary skill in the art to use short message service because it would have enabled the system to provide made use of existing wireless messaging

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infrastructure and made use of existing SMS program already built into existing wireless mobile devices.

(10) Response to Argument

Applicant asserts that the examiner's reason for combining the references is "nonsensical". Applicant argues that the USENET posting is directing only to WebTV devices; hence applying the teaching of the posting to servicing of wireless mobile devices is "nonsensical". Applicant argued that the references used are not directed at solving problem of wireless mobile devices. Applicant argued that the references must solve the same problems addressed by Applicant in arriving at the claimed invention.

This argument is not persuasive. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather, the test is what the combined teachings of the references would have

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suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

First Applicant characterizes the problem as limited to the field of wireless mobile devices. The argument is not persuasive because the problem being solved is not unique to wireless mobile devices. The problem and solution is applicable to broader ranges of devices - namely permitting a limited capability device the ability to participate in an IRC chat session.

Here, the WebTV Posting teaches providing a proxy that translates commands from a limited computing device (WebTV) to IRC commands so as to enable the user of the device to fully participate in Internet-Rely-Chat (IRC) as that of a computer user. Hence, the WebTV Posting solves similar problem as that faced by applicant in substantially the same way - by providing a proxy that intercepts and translates chat commands from the limited computing device and forward the translated command to an IRC server. Given the teaching of the WebTV Posting, one of ordinary skill in the art implementing a system to permit user of wireless mobile device to fully participate in IRC network would have motivated to provide a proxy server to translate commands from the wireless mobile device to IRC commands as disclosed by the Posting.

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Bunney also provides a similar solution. Bunney faces a problem of translating non-standard nicknames of his subscribers to 9 characters nicknames required by IRC network. Bunney solution is to provide a proxy server that intercepts the user chat commands, translates the non-standard name to that conforming the IRC standard, and forwards the translated chat commands to the IRC server. Hence, the references are analogous art and teach solutions to problems analogous to that faced by Applicant.

Second, Applicant attempts to distinguish the invention by reciting that client device is a wireless mobile device and the proxy server is position between a wireless Internet gateway and the IRC server. Providing wireless mobile device connection to the Internet via an Internet gateway is a conventional network architecture well known in the art at the time of the invention. (See for example Ramasubramani fig.1). Bunney's fig.5 shows a phone device 3 connects to chat proxy 20 which in turn connect to IRC server 40. The client device 3 connects to the proxy via the Internet (see fig.1). Bunney does not explicitly shows a wireless Internet gateway between device 3 and the proxy 20. Bunney fig.5 is a high level diagram and does not show all the details or all network elements involved to permit the device 3 to connect to proxy 20. The Internet is merely shown as a cloud

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in fig.1. The Internet gateway is an inherent network element and must exist in order to provide the mobile device 3 connection to the Internet (as evidence by Ramasubramai). Hence, Bunney's proxy 20 inherently is positioned between an Internet gateway for device 3 and the IRC server 40.

In the WebTV posting, the chat proxy is a server on the Internet. Hence, the WebTV devices in order to reach the proxy server needs to have Internet access - e.g. going through WebTV Internet gateway. Hence, the WebTV chat proxy inherently is positioned between the IRC server and the WebTV Internet gateway.

Hence, in following the teaching of Bunney and WebTV to provide full IRC support for the wireless mobile devices such as that of Burgan, it is obvious that the chat proxy would be positioned between a wireless Internet gateway and the IRC server.

As per the argument concerning the 'ghosting' command, as admitted by Applicant (specification page 28), 'ghosting' as claimed is merely the IRC user 'mode +i' command. The WebTV Posting clearly discloses the proxy can handle MODE commands. Hence, the system as modified inherently has the capability to translate and send a 'ghosting' command to IRC 'mode +i' command. The rejection specifically provided the obviousness

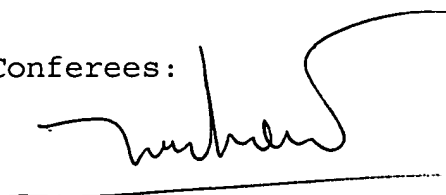

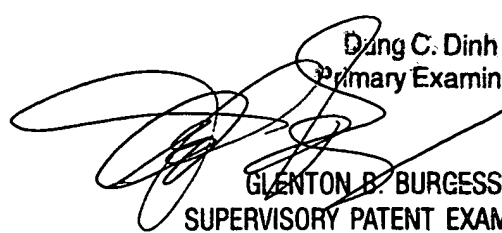
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motivation for providing mode +i command - to hide the user nickname when he does not wish to let others know that he is in the chat channel. This is the conventional purpose for using the mode +i command in IRC.

As per the argument concerning the usage of short message system (SMS) controller and SMS program on the wireless mobile device, SMS is a well-known text messaging service provided for wireless mobile devices (e.g. cell phones and pagers - see Gudjonsson col.1 lines 19-31). Hence, it is well known in the art to have cell phone with built in SMS program for sending text messages. Gudjonsson further teaches mobile user can communicate with PC user via SMS (col.3 line 57 "PC to SMS"). Hence using SMS for sending chat text messages from a wireless device such as a cell phone would have been obvious to one of ordinary skill in the art because it would have enabled one to use existing wireless text message transport and program already in the cell phone instead of having to create new network protocol and installing new program into the cell phone.

For the above reasons, it is believed that the rejections should be sustained.

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